

**REMARKS**

Claims 27-63 are pending, claims 28, 31, 41, 45, 46, 47, 48, 53, 54, 57, 59, 60 and 61 having been amended.

**Claim Amendments & § 112**

Claims 28, 31, , 46, 48, 57, 59, 60 and 61 have been amended to change "is comprised" to "is."

Claims 41, 45, 47, 53 and 54 have been amended to have proper antecedent basis.

Claims 47, 53 and 60 have been amended to remove "if appropriate."

Accordingly, the rejection of claims 28-63 as being indefinite under 35 USC § 112, second paragraph, should be withdrawn.

**§ 102(e)**

Claims 28-39 and 43-45 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dubois (USP App Pub No 2003/0088124). Applicants respectfully traverse this rejection.

Dubois does not teach each element of the presently claimed invention, as set forth in representative claim 28. For example, Dubois describes the preparation of acrylic acid from propane in the absence of molecular oxygen. See, e.g., paragraphs [0006] and [0014]. Moreover, in Dubois, reference to oxygen is only for catalyst regeneration and not for the acrylic acid preparation reaction.

However, as set forth in representative claim 28, the presently claimed process is carried out in the presence of molecular oxygen with a molar ratio of propane/oxygen superior or equal to 0.5.

Accordingly, the presently claimed process is not anticipated by Dubois.

Dubois only qualifies as prior art under § 102(e). Moreover, as evidenced in the Statement Concerning Common Ownership section, *supra*, application 10/526,877 (the present application) and application 10/093,265, Dubois (USP App Pub No 2003/0088124), were, at the time the invention of Application 10/526,877 was made, owned by Atofina.

According to MPEP § 706.02(I)(2), Dubois (USP App Pub No 2003/0088124) is now disqualified from being used in a rejection under 35 U.S.C. § 103(a) against the currently pending claims.

Accordingly, applicants respectfully request that the rejection of claims 28-39 and 43-45 as being anticipated, be withdrawn.

### **§ 103(a)**

Claims 40-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubois (USP App Pub No 2003/0088124). Applicants respectfully traverse this rejection.

Dubois only qualifies as prior art under § 102(e). Moreover, as evidenced in the Statement Concerning Common Ownership section, *supra*, application 10/526,877 (the present application) and application 10/093,265, Dubois (USP App Pub No 2003/0088124), were, at the time the invention of Application 10/526,877 was made, owned by the same company, Atofina, which has changed its name to Arkema.

According to MPEP § 706.02(I)(2), Dubois (USP App Pub No 2003/0088124) is now disqualified from being used in a rejection under 35 U.S.C. § 103(a) against the currently pending claims.

Accordingly, applicants respectfully request that the rejection of claims 40-42 as being unpatentable, be withdrawn.

Claims 46-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dubois (USP App Pub No 2003/0088124) in view of FR 2833005, as evidenced by counterpart Dubois II (USP App Pub No 2005/0054880). Applicants respectfully traverse this rejection.

As identified above, Dubois (USP App Pub No 2003/0088124) cannot be used in a rejection under 35 U.S.C. § 103(a) against the currently pending claims.

Dubois II is relied upon by the Examiner to allegedly teach the required cocatalyst at paragraph [0012]+. However, this does not remedy the deficiencies in the Examiner's rejection because Dubois (USP App Pub No 2003/0088124) cannot be used.

Accordingly, applicants respectfully request that the rejection of claims 46-63 as being unpatentable, be withdrawn.

### **Double Patenting**

Claims 28-63 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-63 of copending Application No. 10/526,879.

Applicants file herewith a terminal disclaimer, disclaiming the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the earliest expiration date of the full statutory term defined in 35 U.S.C. §§ 154 and 173 as presently shortened by any terminal disclaimer, of pending Application No. 10/526,879.

Accordingly, the present double patenting rejection is respectfully requested to be withdrawn.

Claims 28-63 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/497,210.

The claims of Application No. 10/497,210 do not render the presently claimed invention obvious. The claims of Application No. 10/497,210 specifically recite that the process is for the manufacture of acrylic acid from propane, in which a gas mixture is **devoid of molecular oxygen**. There is nothing in the previous reference that could suggest to one skilled in the art that a change would be helpful to improve the process.

Moreover, MPEP § 2143.01(VI) recites that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Here, the claims of Application No. 10/497,210 specifically recites a principal of operation for the manufacture of acrylic acid from propane, which is based on the gas mixture being **devoid of molecular oxygen**. Thus, modifying the claims of Application No. 10/497,210 to the presently claimed invention, which recites a process that is carried out in the presence of

molecular oxygen with a molar ratio of propane/oxygen superior or equal to 0.5, would change the principal of operation of the claims of Application No. 10/497,210.

Accordingly, the claims of Application No. 10/497,210 do not render the presently claimed invention obvious.

Accordingly, the present double patenting rejection is respectfully requested to be withdrawn.

### **Conclusion**

Favorable examination and further action in the form of a Notice of Allowance is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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